

REMARKS

Favorable consideration and allowance are respectfully requested for claims 1-14 in view of the following remarks.

In the Office Action dated April 8, 2003 (the "Office Action"), claims 1-14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

Rejection under 35 U.S.C. § 112, second paragraph

The definiteness of a claim is determined by whether one skilled in the art would comprehend the claim boundaries when reading the claim in view of the specification, *Orthokinetics Inc. v. Safety Travel Chairs, Inc.* 1 USPQ2d 1081 (Fed. Cir. 1986). Applicant respectfully submits that the language of pending claims 1-14 clearly delineates the boundaries of what is claimed.

The Office Action suggests that the claims are indefinite because "[i]n this instance the applicants fail to specifically name or recite what types or class of polymers would be useful." See the Office Action at page 2. Applicant submits that the term "polymers" is sufficiently definite by itself, as one skilled in the art can readily determine whether or not a given material is a polymer. Applicant urges the Examiner to consider *In re Skoll*, 187 USPQ 481 (C.C.P.A. 1975), where the court overturned a rejection alleging that the expression "organic and inorganic acids" was indefinite under 35 U.S.C. § 112, second paragraph. The court explained "although a large number of acids would come within the scope of the expression, it is not indefinite" and "[w]e see no reason to believe that the public would be confused as to what *subject matter* is circumscribed by appellant's claim." *In re Skoll* at 482 (emphasis in original). The court also indicated "whether or not a substance comes within the class of 'organic and inorganic acids' is rendered no less certain by the large number of substances within the class." *In re Skoll* at 483.

The Office Action also suggests that it is improper to describe an article by its physical characteristics. Applicant respectfully submits that a material may

be claimed not only by its structure, but also by its physical properties or by process steps. The U.S. Court of Appeals for the Federal Circuit recently affirmed this practice in *Fiers v. Revel*, 25 USPQ2d 1601 at 1605, (1993) stating “[w]e recognized that, in addition to being claimable by structure or physical properties, a chemical material can be claimed by means of a process.” Further, in *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.* 23 USPQ2d 1801 at 1805 (Fed. Cir. 1992), the court indicated “that ‘at least since 1891’ it has been permissible to claim a new product by describing it with process terms, when the inventor finds that his invention is incapable of description solely by structure or physical characteristics.” See also *In re Hughes* 182 USPQ 106 at 107-108 (C.C.P.A. 1966) and *In re Hallman* 210 USPQ 609 (C.C.P.A. 1981) (holding that product claims may be drafted to include process steps to wholly or partially define the claimed product). Although these cases concerned the use of process steps to claim a material, the language clearly indicates that it is acceptable to claim a material with reference to physical characteristics.

The courts have repeatedly affirmed the allowability of claims describing the invention by physical characteristics. See, e.g., *In re Saether*, 181 USPQ 36 at 37 (C.C.P.A. 1974), which indicates “[t]he invention is an elastomeric platform defined by certain specific physical characteristics rather than ingredients...” See also *In re Echerd and Watters* 176 USPQ 321 at 322 stating

[t]here is nothing intrinsically wrong in defining something by what it does rather than by what it is... Here, the flexibility, wet strength and latent adhesive requirements recited in the claims must be recognized as positive qualities of appellant’s product.

In the latter case, the court expressly approved claim language describing the physical properties of the claimed material and relied on these limitations on the claimed material, distinguishing it from the cited reference.

Thus, the test for indefiniteness does not depend upon whether an invention is described by its structure or by a process, or by its physical characteristics. Any of these descriptions is sufficient. Even the use of broad descriptive terms does not create indefiniteness.

In the present instance, the claim recites the word "polymers" which is well defined in the art. The claimed material is further limited by recitations of physical characteristics, which are readily determinable by persons skilled in the art. Thus, the film that is the subject of the claim is defined by both structural and physical characteristics, and one skilled in the art can readily determine the boundaries of each of claims 1-14. Applicant submits that the claims do particularly point out and distinctly claim the subject matter which applicant regards as the invention, and that the rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph should be withdrawn, for at least the foregoing reasons.

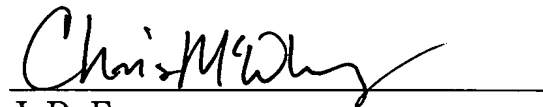
Conclusion

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #148/50801).

Respectfully submitted,

August 8, 2003



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